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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,617	04/02/2004	Kia Silverbrook	HYG009US	9393
24011 7590 02/10/2009 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER FRANKLIN, JAMARA ALZAIDA	
			ART UNIT 2876	PAPER NUMBER
			MAIL DATE 02/10/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,617

Applicant(s)

SILVERBROOK ET AL.

Examiner

JAMARA A. FRANKLIN

Art Unit

2876

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 9, 33, 34, 48-50, 52, 53 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 33, 34, 48-50, 52, 53 and 57-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/09/08 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 57-59 and therefore claims 8, 33, 48-50, 52, 53, and 57-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 57, 58, and 59 cite "the sensing data is indicative of a communication request associated with a provider". What is this provider and what exactly does this provider provide?

For examination purposes, the provider will be interpreted to be a network provider.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8, 33, 48, 49, 52, 53, and 57-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Dymetman et al. (US 6,330,976) (hereinafter referred to as "Dymetman").

Dymetman teaches

regarding claim 57, a method of facilitating a communication using a product item, the product item including a surface having disposed thereof or therein coded data portions, each coded data portion (cells 202) encoding a product item identifier and position information identifying the position of the coded data portion on the surface of the product item, the method including the steps of:

receiving sensing data from a user device (pointer 502), the sensing data resulting from sensing one of the coded data portions;

determining from the position information that the sensing data is indicative of a communication request associated with a provider;

determining a provider address using the product item identifier (col. 9, lines 29-31);

providing to the user device the provider address associated with the provider (col. 9, lines 31-34);

receiving from the user device a message and a destination address sent to the provider address (col. 9, lines 34-39); and

forwarding the message to the destination address (col. 9, lines 34-39);

regarding claim 58, a method of facilitating a communication using a product item, the product item including a surface having disposed thereof or therein coded data portions, each coded data portion encoding a product item identifier and position information identifying the position of the coded data portion on the surface of the product item, the method including the steps of:

receiving sensing data from a user device, the sensing data resulting from sensing one of the coded data portions;

determining from the position information that the sensing data is indicative of a communication request associated with a provider;

determining the provider using the product item identifier;

facilitating the communication; and

transferring a payment request for the communication to the provider (col. 17, lines 52-61);

regarding claim 59, a method of facilitating a communication using a product item, the product item including a surface having disposed thereof or therein coded data portions, each coded data portion encoding a product item identifier and position information identifying the position of the coded data portion on the surface of the product item, the method including the steps of:

receiving sensing data from a user device, the sensing data resulting from sensing one of the coded data portions;

determining from the position information that the sensing data is indicative of a communication request associated with a provider;

determining the provider using the product item identifier;

extracting from the sensing data a message and a destination address;

sending to the provider address associated with the provider at least the message and the destination address; and

forwarding, by the provider, the message to the destination address (figure 2);

the method of claim 57 wherein the method further includes the steps of:

generating using product item identifier product item information; and

providing the product item information as part of the message;

the method of claim 59 wherein the method further includes the steps:

generating, using the product item identifier, product item information; and

providing the product item information as part of the message;

the method of any one of claims 57, 58, and 59 wherein the product item uniquely identifies the product item (see abstract);

the method of any one of claims 57, 58, and 59 wherein the coded data is redundantly encoded (figures 3 and 4);

the method of any one of claims 57, 58, and 59 wherein the coded data is substantially invisible to the unaided eye (figure 4); and

the method of any of claims 57, 58, and 59 wherein the coded data is printed using infrared ink (col. 12, lines 17-19).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 9 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman in view of Matsumoto et al. (US 6,763,334) (hereinafter referred to as 'Matsumoto').

The teachings of Dymetman have been discussed above.

Dymetman lacks the teaching of embedding advertising material with a the message.

Matsumoto teaches a method including a step of embedding advertising material within a message prior to forwarding the message (col. 2, lines 41-45).

One of ordinary skill in the art would have readily recognized that providing the Dymetman invention with embedded advertising material would have been beneficial since the type of information embedded into code is limitless. Sharing advertising material would benefit

the party which shares it since advertising is inherently used to promote a product or service for the financial or social gain of the sharing party. Therefore it would have been obvious at the time the invention was made to modify the teachings of Dymetman with the aforementioned teaching of Matsumoto.

Response to Arguments

9. Applicant's arguments with respect to claims 8, 9, 33, 34, 48-50, 52, 53, and 57-60 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMARA A. FRANKLIN whose telephone number is (571)272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamara A. Franklin/
Primary Examiner, Art Unit 2876

JAF
February 05, 2009